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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,737	12/06/2004	Kazuhiro Shimura	OGW-0343	6957
23353	7590	08/07/2006	EXAMINER	
RADER FISHMAN & GRAUER PLLC			FISCHER, JUSTIN R	
LION BUILDING			ART UNIT	
1233 20TH STREET N.W., SUITE 501			PAPER NUMBER	
WASHINGTON, DC 20036			1733	

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/516,737	SHIMURA, KAZUHIRO	
	<b>Examiner</b>	<b>Art Unit</b>	
	Justin R. Fischer	1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-14 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12604</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Pollack (WO 01/36220). As best depicted in Figure 3A, Pollack is directed to a pneumatic tire construction in which a transponder module 200 is sandwiched between sheet-shaped members 302, 304. The reference further teaches that the edges of the sheet-shaped members are sealed (Page 28, Lines 27+).

As to claim 8, the method of Pollack involves the use of an adhesive 306 to bond the thus formed assembly onto the inner surface of the tire.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5-7, and 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pollack. As noted above, Pollack is directed to a pneumatic tire construction in which a transponder module 200 is sandwiched between sheet-shaped members 302, 304. While the reference fails to expressly suggest that the transponder

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is slidable, a fair reading of the reference suggests such an arrangement. In particular, the reference suggests that the transponder is "sandwiched" between the respective sheet-shaped members and furthermore, that the peripheral edges of said members are sealed- these teachings suggest that the transponder is not adhered to the respective sheet-shaped members but rather is slidably disposed therebetween. Thus, one of ordinary skill in the art at the time of the invention would have found it obvious to include a transponder within a sandwiched assembly, such that said transponder is slidable.

As to claims 3 and 9, the claims define the basic structure of transponders and as such, one of ordinary skill in the art at the time of the invention would have expected the transponders of Pollack to include the claimed elements.

Regarding claims 5 and 10, Pollack describes the sheer-shaped members as "thin"- such a description appears to be consistent with the claimed thickness values between 0.2 and 0.8 millimeters, there being no conclusive showing of unexpected results to establish a criticality for the claimed thickness (Page 28, Lines 27+).

With respect to claims 6, 7, and 11-14, Pollack teaches the use of sheet-shaped members, **such as rubber sheets**. It is evident that rubber sheets are exemplary and one of ordinary skill in the art at the time of the invention would have found it obvious to use additional materials for the sheet-shaped members. In particular, one of ordinary skill in the art at the time of the invention would have found it obvious to use a high melting point material such that the sheet-shaped members retain their integrity and do not melt (and flow) during vulcanization. Thus, given the common vulcanization conditions of tires, one of ordinary skill in the art at the time of the invention would have

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found it obvious to select a resin material having a melting point above 150 degrees Celsius. With specific respect to claim 7, fluorocarbon resins, such as PTFE, are extremely well known and conventionally used in a wide variety of applications where anti-adhesive properties are desired- in this case, the transponder of Pollack is slidably disposed between sheet-shaped members. The particular selection of a fluorocarbon resin is consistent with the tire of Pollack in which the transponder is not attached to either of said sheet-shaped members. Lastly, applicant has not provided a conclusive showing of unexpected results to establish a criticality for the use of fluorocarbon resins.

#### ***Allowable Subject Matter***

5. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art references of record fail to disclose, suggest, or teach a tire construction in which the claimed transponder assembly is placed on the outer surface of a tire and is formed with at least one transparent sheet-shaped member.

#### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Justin R. Fischer** whose telephone number is **(571) 272-1215**. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Justin R Fischer  
Primary Examiner  
Art Unit 1733

JRF  
July 24, 2006